

U.S. Application Serial No. 10/532,380
Atty. Docket No. 10191/3897
Reply to Office Action of November 1, 2006

AMENDMENTS TO THE DRAWINGS:

The attached Replacement Sheet includes replacements for Figures 1 and 2. The sheet replaces the original sheet containing Figures 1 and 2.

Attachment: One Replacement Sheet

REMARKS

Claims 12 to 22 are pending in the present application.

In view of the following, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

As to paragraph three (3) of the Office Action, the Specification was objected to for an informality. Accordingly, the Figure 1 of the Drawings is amended herein to bring the Drawings and the Specification into agreement. It is therefore respectfully requested that the objection be withdrawn.

As to paragraph four (4) of the Office Action, Claims 12 to 22 were rejected under 35 U.S.C. § 112, second paragraph, as indefinite. Specifically claims 12, 13, and 16 were rejected to for their use of the term “appropriate.” Claim 14 was rejected for its use of the term “taken into consideration.” Claim 16 was rejected as “it is not clear what a basis of a power stage is.” *Office Action* at 2. Finally, claim 20 was rejected for its use of the term “second degree of freedom.”

Accordingly, claims 12, 13, and 16 are amended herein removing the term “accordingly,” and claim 14 is amended herein removing the term “taken into consideration.” As to the rejection that it is “it is not clear what a basis of a power stage is,” Applicants submit that the term power stage is clearly explained in the specification. *See, e.g., Substitute Specification*, p. 7, l. 8-21. To be definite, it is only necessary that a person having ordinary skill in the art would understand what is claimed when the claim is read in view of the specification. *See Miles Labs., Inc. v. Shandon, Inc.*, 997 F.2d 870, 27 U.S.P.Q.2d 123 (Fed. Cir. 1993). Since a person having ordinary skill in the art would plainly understand what is claimed by claim 16, as presented, when read in view of the Specification, it is respectfully submitted that claim 16 is definite, as presented.

Finally, claim 20 is amended herein removing the term “second degree of freedom.”

Therefore, claims 12 to 22 are definite.

As to paragraph six (6) of the Office Action, claims 12, 13, 18, 19, 21, and 22 were rejected under 35 U.S.C. § 102(b) as anticipated by Hara et al., U.S. Patent No. 5,713,814.

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically

described or contained in a single prior art reference. (See Scripps Clinic & Research Foundation v. Genentech, Inc., 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the prior Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (See Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; and see Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'l. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

Claim 12, as presented, is to a “method for setting an operating point of a drive train,” which includes the feature of “selecting an appropriate characteristic map from a plurality of characteristic maps on the basis of a required electrical power” and the feature of “as a function of the characteristic map, selecting the operating point on the basis of a plurality of at least one of kinematic and dynamic degrees of freedom.”

The Hara reference does not identically disclose (or even suggest) the feature of selecting an appropriate characteristic map from a plurality of characteristic maps on the basis of a required electrical power, as provided for in the context of claim 12, as presented. First, the Hara reference does not identically disclose (or even suggest) the feature of selecting an appropriate characteristic map from a plurality of characteristic maps. Nothing in the Hara reference identically discloses (or even suggests) the feature of characteristic maps at all, and, therefore, nothing in the reference can disclose (or suggest) *selecting* a characteristic map from a plurality of characteristic maps. In addition, the Hara reference does not identically disclose (or suggest) selecting an appropriate characteristic map *on the basis of a required electrical power*. The Office Action suggests that the “battery state of charge, understood to be inversely proportional to the power required by the battery is employed to select amongst a plurality of ‘appropriate’ character (e.g., figures 14, 15, 16).”

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Office Action at 3. However, in the Hara reference, the system only determines whether the battery is able to supply power and does not identically disclose (or even suggest) the feature of selecting an appropriate characteristic map *on the basis of a required electrical power*.

In addition, the Hara reference does not identically disclose (or even suggest) the feature of as a function of the characteristic map, selecting the operating point on the basis of a plurality of at least one of kinematic and dynamic degrees of freedom, as provided for in the context of claim 12, as presented. Nothing in the Hara reference identically discloses (or even suggests) the feature of selecting an operating point *as a function of the characteristic map*. Rather, the reference states that “the engine operating point, that is, RPM and torque, is set, at Step S33, based upon the vehicle speed obtained from the vehicle speed sensor 14 and from the throttle opening obtained from the throttle sensor.” (Col. 7, l. 63-67.) The reference does not identically disclose (or even suggest) a characteristic map or selecting an operating point as a function of the characteristic map.

Accordingly, claim 12, as presented, is allowable. Claims 13 to 22 depend from claim 12 and are therefore allowable for at least the same reasons.

As to paragraph nine (9) of the Office Action, claim 20 was rejected under 35 U.S.C. § 103(a) as unpatentable over Hara et al., U.S. Patent No. 5,713,814.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claim 20 depends from claim 12. As explained above, the Hara reference does not disclose or even suggest all of the features of claim 12, as presented. Therefore, claim 20, as presented, is allowable for at least the same reasons that claim 12 is allowable.

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As to paragraph ten (10) of the Office Action, claims 14 to 17 were rejected under 35 U.S.C. § 103(a) as unpatentable over Hara et al., U.S. Patent No. 5,713,814, in view of Yoshino et al., European Patent No. EP1142749.

Claims 14 to 17 depend from claim 12. As explained above, the Hara reference does not disclose or even suggest all of the features of claim 12, as presented. Since, it is not suggested that the Yoshino reference cures the critical deficiencies of the Hara reference, the proposed combination of the Hara reference and the Yoshino reference cannot disclose or even suggest all of the features of claim 12, as presented, or claims 14 to 17 which depend from claim 12. Therefore, claims 14 to 17 are allowable.

In sum, claims 12 to 22 are allowable.

CONCLUSION

In view of the foregoing, it is respectfully submitted that all of the presently pending claims are allowable. It is therefore respectfully requested that the objections and rejections be withdrawn. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is respectfully requested.

Respectfully submitted,

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